

II. REMARKS

A. Introduction

Applicants submit this Response in a bona fide attempt to (i) advance the prosecution of this case, (ii) answer each and every ground of objection and rejection as set forth by the Examiner, (iii) place the claims in a condition for allowance, and (iv) place the case in better condition for consideration on appeal. Applicants respectfully request reexamination and reconsideration of the above referenced patent application in view of this Response.

As indicated above, Claims 1 – 9 have been amended and Claim 10 has been canceled. New Claim 11 has also been added.

Applicants respectfully submit that the noted amendments merely make explicit that which was (and is) disclosed or implicit in the original disclosure. The amendments thus add nothing that would not be reasonably apparent to a person of ordinary skill in the art to which the invention pertains.

B. Response to Objections

1. Specification

The Examiner has objected to Applicants Abstract. The Examiner has requested that the phrase “The present invention relates to” be deleted. As indicated above, the Abstract has been amended accordingly.

2. Claims

The Examiner has objected to Claim 10. As indicated above, Claim 10 has been canceled.

C. Response to Rejections

1. Double Patenting

The Examiner has rejected Claims 1 – 10 under the judicially created doctrine of obviousness-type double patenting “over claims 1 – 10 of U.S. Patent No. 6,702,336”. The Examiner contends that “the claims, if allowed, would improperly extend the ‘right to exclude’ already granted in the patent.” The Examiner further contends:

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

The Examiner has thus concluded that Applicants' invention, as recited in original Claims 1-10, would have been obvious to one having ordinary skill in the art in view of the claims in the '336 patent.

In *In re Kaplan*, 789 F.2d 1574, 229 U.S.P.Q. 678 (Fed. Cir. 1986), the Federal Circuit stressed that to establish "obviousness-type" double patenting as to an attempt to obtain a patent on a variation of an invention claimed in a prior patent, there must be some *clear evidence* why the variation would have been obvious. As set forth below, Applicants respectfully submit that the record is devoid of the requisite clear evidence that the claimed invention would be obvious in view of the '336 patent.

Applicants submit that the pipe coupling embodied in Claims 1 – 9, as amended, and new Claim 11 would not be obvious in view of the '336 patent. As indicated above, Claim 1, as amended, includes, in particular, an insertable pipe length limitation that would not be obvious from the '336 patent disclosure.

Applicants accordingly request that the double patenting rejection be withdrawn.

2. 35 U.S.C. § 102

The Examiner has rejected Claims 1, 3 – 4, 8 and 10 "under 35 U.S.C. § 102 (b) as being anticipated by Harris." The Examiner contends that Harris discloses a pipe coupling having all of the claimed elements and limitations recited in Claims 1, 3 – 4, 8 and 10.

The Examiner has also rejected Claims 1 and 3 – 6 "under 35 U.S.C. § 102 (e) as being anticipated by Egozi." The Examiner similarly contends that Egozi discloses a pipe coupling having all of the claimed elements and limitations recited in Claims 1 and 3 – 6.

It is well established that a rejection for anticipation under § 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. *See In re Paulsen*, 30 F.3d 1475, 1478-79, 31 U.S.P.Q. 2d 1671, 1673 (Fed. Cir. 1994); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 U.S.P.Q. 2d 1001 (Fed. Cir. 1991). *See also American Permahedge, Inc. v. Barcana, Inc.*, 857 F. Supp. 308, 32 U.S.P.Q. 2d 1801,

1807-08 (S.D. NY 1994) (“Prior art anticipates an invention ... if a single prior art reference contains each and every element of the patent at issue, operating in the same fashion to perform the identical function as the patent product. ... Thus, any degree of physical difference between the patented product and the prior art, *no matter how slight*, defeats the claim of anticipation.”); *Transco Ex parte Levy*, 17 U.S.P.Q. 2d 1461, 1462 (Bd. Pat. App. & Int'l 1990) (“[I]t is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference”.)

Applicants respectfully submit that Claim 1, as amended, and Claims 3 – 6 and 8, dependant thereon, are patentably distinguishable from Harris and Egozi. As set forth in the specification, a key feature and, hence, advantage of Applicants’ coupling is the provision of a “positive” first stop that contacts and holds an end of a pipe manually inserted therein at a fixed first position, whereby when the coupling nut is further tightened the pipe is caused to move axially toward a second position, wherein the pipe contacts a positive second stop. The coupling thus prevents the pipe from being manually inserted too far into the coupling.

Applicants respectfully submit Harris does not disclose the noted features. Harris specifically provides:

Assuming the pipe 11 is inserted into the socket 17 of the coupling as shown in FIGS. 1 and 2, initial tightening of the nut 30 on the body 12 will not cause abutment of shoulder 33 with annular surface 34 of the sleeve 24. The inner end of the gripping member 25 is loosely contained with a recess 36 in the outer end of the sleeve 24, and the gasket ring 18, sleeve 24 and gripping member 25 move in together with the nut 30 since there is a clearance of all portions of the coupling around the polymeric pipe 11 when it is first inserted. However, after the nut 30 travels a short axial distance inwardly the gasket ring 18 is intercepted by the step 21 and will not pass that step until compressed. Continued movement of the nut therefore causes a small axially inward movement of the sleeve 24 and the gripping member 25, and must be accommodated by the sliding of inner surface 32 over the outer tapered surface 27, in turn causing the barb projections 26 of the gripping member 25 to engage the outer surface of pipe 11. Tightening of the nut 30 also brings the shoulder 33 into abutment with the annular surface 34 of compression sleeve 24 and progresses the sleeve 24 axially inwardly, causing sufficient compression of the gasket ring 18 for it to enter the inner smaller diameter intermediate portion 19 of

the socket 17. The socket is of such dimension that the gasket ring 18 effects a satisfactory seal between the body 12 and the pipe 11, and this further enhanced when the nut 30 is fully tightened so that the two surfaces of the 24 respectively lie in abutment with the outer end 15 of the body 12 and the shoulder 33 as shown in FIG. 2. Col.4, ll. 17 – 45.

Harris' coupling thus merely employs a single stop (or abutment surface).

Egozi discloses a pipe coupling having a body member that includes a "plurality of deformable stops."

[B]ody member 2 further includes a plurality of deformable stops 25 within the inner bore 22. Stops 25 are preferably integrally formed with body member 2, but could be separate inserts received within the body member. The stops are engageable with the end of the pipe P when inserted into the coupling, and are deformable under a force...to permit some inward axial movement of the pipe during the final tightening of the nut 3.

* * *

[E]ach vane 25... serves as an initial stop for limiting the inward movement of the pipe when inserted into the body member, but the final tightening of the nut 3 produces an axial force tending to move the pipe further inwardly of the bore, which further movement is permitted by the deflection of the vanes 25 more tangentially towards the inner surface of the bore.

Col. 3, ll. 30-38, 47-53

Applicants respectfully submit that, although the force required to displace the deformable stops (or vanes) and, hence, move the pipe axially inward is not disclosed, it is reasonable to conclude that the required axial force would not be substantially greater than the force required to manually insert the pipe into the coupling. Further, in contrast to Applicants' positive, non-deformable stop, the first abutment position would thus vary as a function of the manual (or axial) insertion force. By virtue of the configuration of the vanes, the first abutment position would also vary as a function of the outer diameter of the pipe inserted into the coupling.

Furthermore, as will be appreciated by one having ordinary skill in the art, the vanes can, and in many instances will, disrupt the flow through the pipe and coupling.

Applicants thus respectfully submit that the pipe coupling embodied in Claims 1-10, as amended, and New Claim 11 is not anticipated by Harris or Egozi.

3. 35 U.S.C. § 103

The Examiner has also rejected dependent Claims 1 – 2 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Anderson, et al. The Examiner contends that Anderson, et al. discloses all of the limitations of Applicants' pipe coupling; except, "a plurality of borbs".

The Examiner further contends that "it would have been obvious to a person having ordinary skill in the art to add additional barbs to the gripping member because duplicating the components of a prior art device is a design consideration within the skill in the art."

In determining what is and what is not obvious under § 103, all properties and advantages not in the prior art must be considered. See *In re Wright*, 848 F.2d 1216, 6 U.S.P.Q. 2d 1959, 1962 (Fed. Cir. 1988) ("Factors including unexpected results, new features, solution of a different problem, novel properties, are all considerations in the determination of obviousness in terms of 35 U.S.C. § 103"). Indeed, it is the invention as a whole, including distinct functions that must be considered in obviousness determinations.

Further, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. See *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 922 (Fed. Cir. 1984).

Applicants respectfully submit that Claims 1 – 9 (and new Claim 11) define an invention that is unobvious over Anderson, et al. Anderson, et al. specifically provides:

The bore of the sleeve 10 is, as noted above, formed with a bore to receive the free end of the pipe 12 and has a shoulder 29 that acts as a stop means to the force of manual entry of the pipe 12.

* * *

... the stop means 29 is designed to locate the free end of the pipe 12 in the sleeve 10 upon entry of the pipe under the force of manual entry and the inward taper is designed to admit the pipe in an axial direction beyond the stop means ... (emphasis added)

Col. 4, ll. 1-23.

Anderson, et al.'s coupling thus merely employs one stop. Further, the stop is specifically designed and adapted to permit axial movement of the pipe past the stop into a tapered region (and, hence, not a positive second stop) that further restricts axial movement. The Anderson, et al. coupling is thus highly susceptible to over-insertion of a pipe into the coupling and, hence,

deformation and changes in flow resulting therefrom, and/or rupture of the pipe when the pipe is further drawn into the coupling upon tightening of the nut.

Applicants thus respectfully submit that Claims 1 – 9 and new Claim 11 define an invention that is unobvious over Anderson, et al. Claims 1 – 9 and 11 should thus be deemed allowable.

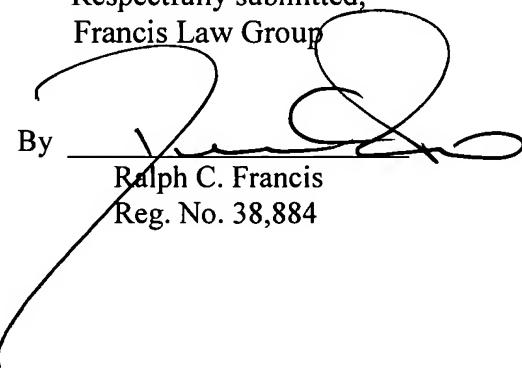
III. CONCLUSION

Applicants having answered each and every ground of rejection as set forth by the Examiner, and having added no new matter, believe that this response clearly overcomes the references of record, and now submit that all claims in the above-referenced patent application are in condition for allowance and the same is respectfully solicited.

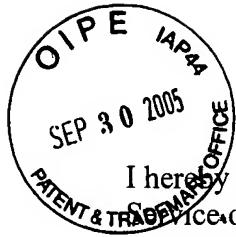
If the Examiner has any further questions or comments, Applicants invite the Examiner to contact his Attorneys of record at the telephone number below to expedite prosecution of the application.

Respectfully submitted,
Francis Law Group

By


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